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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,380	01/15/2004	Memphis-Zhihong Yin	200312170-1	5429

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EXAMINER

WRIGHT, INGRID D

ART UNIT PAPER NUMBER

2835

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/758,380	Applicant(s) YIN ET AL.	
	Examiner Ingrid Wright	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 2, it is unclear how different functions overlap.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-16,19-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikinis et al. (US PN 5689654).

With respect to claim 1, Kikinis et al. teaches (Fig. 5) a notebook computer(172), comprising: an internal device bay (105) with an electrical

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connector (26) disposed therein; and a multi-functional device (10) insertable in the internal device bay (105) and connectable to the electrical connector(26); and wherein the multi-functional device (10) has a first set of functions (See for example, Column 11, Lines 25-35) when the multi-functional device (10) is inserted into the internal device bay (105) and connected to the electrical connector (26) and a second set of functions (See for example, Column 11, Lines 64-66) different from the first set of functions when removed from the internal device bay (105).

With respect to claim 3, Kikinis et al. teaches (Fig. 1A) the first set of functions comprises file storage (13) (Column 7, Lines 44-53).

With respect to claim 4, Kikinis et al. teaches (Fig. 3) the multi-functional device (10) comprises a multi-functional storage drive (Column 8, Lines 44-7-20).

With respect to claim 5, Kikinis et al. teaches (Fig. 3) the first set of functions comprises transferring content across the electrical connector (26) (Column 7, Lines 44-62).

With respect to claim 6 & 18, Kikinis et al. teaches (Fig. 3) the second set of functions comprises creating content (Column 7, Lines 44-62).

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With respect to claims 7,9 & 22, Kikinis et al. teaches (Fig. 3) the multi-functional device (10) comprises at least a PDA.

With respect to claim 8, Kikinis et al. teaches (Fig. 3) the second set of functions comprises playing content (via equipment 19, for example).

With respect to claim 10, Kikinis et al. teaches (Fig. 5) the multi-functional device (10) is insertable fully into the internal device bay (105).

With respect to claim 11, Kikinis et al. teaches (Fig. 5) the multi-functional device (10) is inserted into the internal device bay (105) and connected to the electrical connector (26), the multi-functional device (10) has a side that is accessible externally of the computer (172) in accordance with at least part of the first set of functions.

With respect to claim 12, Kikinis et al. teaches (Fig. 5) a multi-functional device (12) that can be connected to a personal electronic system having an internal device bay (105) and an electrical connector (26) accessible within the internal device bay (105), comprising: a body (12) insertable at least partially into the internal device bay of the personal electronic system; and a mating electrical connector (14) adapted to connect to the electrical connector (26) of the personal electronic system upon inserting the multi-functional device (10) into the internal device bay; and wherein: the multi-functional device operates in a first functional

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capacity when inserted at least partially into the internal device bay and connected to the electrical connector; and the multi-functional device (10) operates in a second functional capacity (See for example, Column 11, Lines 64-66) different from the first functional capacity (See for example, Column 11, Lines 25-35) when removed from the personal electronic system.

With respect to claim 13, Kikinis et al. teaches (Fig. 5) the personal electronic system comprising a computer (172).

With respect to claim 14, Kikinis et al. teaches (Fig. 5) the multi-functional device (10) operates in the first functional capacity under control of the personal electronic system (Column 7, Lines 44-62).

With respect to claim 15, Kikinis et al. teaches (Fig. 3) the multi-functional device (10) exchanging content with the personal electronic system.

With respect to claim 16, Kikinis et al. teaches (Fig. 3) the multi-functional device (10) comprising a file storage device (13).

With respect to claim 17, Kikinis et al. teaches the second functional capacity (See for example, Column 11, Lines 64-66 of Kikinis et al.) operating independently of the personal electronic system.

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With respect to claim 19, Kikinis et al. teaches (Fig. 3) the multi-functional device (10) plays content.

With respect to claim 20, Kikinis et al. teaches a storage media aperture (See for example, Column 8, Lines 1-20) in a front sidewall of the body (12) through which a storage media is inserted into and removed from the multi-functional device (10).

With respect to claim 21, Kikinis et al. teaches the storage media aperture is accessible when the multi-functional device (10) is inserted into the internal device bay (105).

With respect to claim 23, Kikinis et al. teaches (Fig. 5) a multi-functional device (10) for use with a computer system (172) having an internal device bay (105), comprising: a housing means adapted to fit at least partially in the internal device bay (105) of the computer system (172); and means for electrical connection (26) to the computer system when the multi-functional device (10) is at least partially in the internal device bay (105); and wherein: the operation of the multi-functional device (105) is controllable by the computer system (172) when the multi-functional device (10) is at least partially in the internal device bay (105); content is transferable between the multi-functional device (105) and the computer system across the electrical connection (26) means when the multi-functional device (10) is at least partially in the internal device bay (105);

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the content is playable by the computer system (172) when the multi-functional device (10) is at least partially in the internal device bay (105); and the content is playable by the multi-functional device (10) when the multi-functional device (10) is not in the internal device bay (105).

Regarding the method claims 24-32, the method steps recited in the claims are inherently necessitated by the device structure as taught by Kikinis et al. Kikinis et al. disclosed (Fig. 5): multi-functional device (10) to a personal electronic system wherein a multi-functional device (10) is at least partially into an internal device bay (105) of the personal electronic system; wherein the multi-functional device (10) in a first functional capacity (See for example, Column 11, Lines 25-35) when the multi-functional device (10) is inserted in the internal device bay (105) of the personal electronic system, wherein device (10) from the personal electronic system is disconnected, wherein the device (10) is removed from the internal device bay (105) of the personal electronic system, wherein the multi-functional device (10) in a second functional capacity (see for example, Column 11, Lines 64-67) different from the first functional capacity when the multi-functional device (10) is removed from the personal electronic system, wherein the personal electronic system comprises a computer system, wherein the first functional capacity includes file storage (See for example, Column 8, Lines 1-20); and further content is stored in the multi-functional device (10) when the multi-functional device (10) is inserted in the internal device bay (105) of the personal electronic system, wherein a removable

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storage media (13) is inserted into the multi-functional device (10); and content is stored onto the removable storage media (13), wherein the first functional capacity includes content exchanged between the multi-functional device (10) and the personal electronic system, wherein the second functional capacity (See for example, Column 11, Lines 64-67) includes content created independently from the personal electronic system, wherein the multi-functional device (10) comprises a PDA, wherein the second functional capacity includes content played independently from the personal electronic system.

With respect to claim 33, Kikinis et al. teaches (Fig. 5) a computer (172), comprising: an internal device bay (105) with an electrical connector (26) disposed therein; and a multi-functional device (10) insertable in the internal device bay (105) and connectable to the electrical connector (26); and wherein the multi-functional device (10) has a first set of functions (See for example, Column 11, Lines 25-35) when the multi-functional device (10) is inserted into the internal device bay (105) and connected to the electrical connector (26) and a second set of functions (See for example, Column 11, Lines 64-66) when removed from the internal device bay (105) and completely disconnected from the computer.

With respect to claim 34, Kikinis et al. teaches (Fig. 5) a multi-functional device (10) that can be connected to a personal electronic system having an internal device bay (105) and an electrical connector (26) accessible within the

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internal device bay (105), comprising: a body (12) insertable at least partially into the internal device bay (105) of the personal electronic system; and a mating electrical connector (14) adapted to connect to the electrical connector (26) of the personal electronic system upon inserting the multi-functional device (10) into the internal device bay (105); and wherein: the multi-functional device (10) operates in a first functional capacity (See for example, Column 11, Lines 25-35) when inserted at least partially into the internal device bay (105) and connected to the electrical connector (26); and the multi-functional device (10) operates in a second functional capacity (See for example, Column 11, Lines 64-66) when removed from the internal device bay (105) and completely disconnected from the personal electronic system.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis et al. (US PN 5689654).

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With respect to claim 2, insofar as the claim language can be understood, Kikinis teaches the first and second sets of functions of device (10) overlap.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have varying functions of the device operative in both the docked and undocked positions in order to expand the capabilities of the overall system.

Conclusion

4 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cipolla et al. (US PN 6587151 B1), Smith, II (US PN 5768163), Kim (US PN 6118653), Fukumitsu et al. (US PN 6141052), Silvester (US PN 6812958 B1), Dickie (US PN 6798647 B2), Homer et al. (US 2004/0233628 A1), Fujiki et al. (US 2003/0095379 A1) show the general state of the art regarding computers having multiport bays and electronic devices integrated to portable computers.

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ingrid Wright whose telephone number is (571) 272-8392. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 272-2800, ext 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/22/05
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